

PATENT

Attorney Docket No. D0932-00426

REMARKS

Claims 1-89 are pending in this application. Claims 62-89 were withdrawn from consideration based on Applicant's election filed on October 26, 2005. Claims 1-61 are rejected.

The withdrawn claims 62-89 and claims 9 and 40 have been canceled without prejudice confirming the election. Independent claims 1 and 32 have been amended. After the entry of the amendments submitted herein claims 1-8, 10-39 and 41-61 remain pending.

Claim Rejection Under 35 U.S.C. § 102

Examiner rejects claims 1-8, 12-14, 19-23, 26-39, 43-45, 50-53 and 56-61 under 35 U.S.C. § 102(b) as being anticipated by United States published Application No. 2003/0008586 to Kajander *et al.* ("Kajander"). For the reasons provided below this rejection is traversed.

Applicant has amended the independent claims 1 and 32 to incorporate the limitations of dependent claims 9 and 40, respectively. Thus, amended claims 1 and 32 now require that the "non-liquid substantially formaldehyde-free binder is about 10 – 30 wt. % of the duct liner" the limitation that were originally recited in the dependent claims 9 and 40.

In rejecting claims originally filed claims 9 and 40 as being anticipated by Kajander, the Examiner fails to state where in the disclosure of Kajander such binder weight percent values are disclosed. In fact, Kajander discloses that the binder "containing essentially free of urea formaldehyde, phenol formaldehyde melamine formaldehyde or furfuryl alcohol formaldehyde resins" is present in very "small amount." (Kajander at paragraph [0008]). Kajander then elaborates that:

[b]y a "small amount" is meant that the binder is no more than about five percent, preferably less than four percent, and most preferably less than three percent of the dry mat and usually is at least 0.3 weight percent, most preferably between about one to three weight percent.

(Kajander at paragraph [0009]). Kajander further states: "[m]ats of the present invention contain . . . preferably 0.75 to less than 3, weight percent binder or binder fiber Binder contents in the dry mat in the range of 2-3 wt. percent are most preferred." (Kajander at paragraph [0018]).

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Therefore, at least for the reasons presented above, Kajander does not disclose the invention as recited in the amended claims 1 and 32 because Kajander does not teach or suggest a duct liner whose non-liquid substantially formaldehyde-free binder content is about 10 – 30 wt. % of the duct liner. Accordingly, the amended claims 1 and 32 are patentably distinguishable over Kajander. Allowance of the amended claims 1 and 32 is kindly requested.

Claim Rejection Under 35 U.S.C. § 103

Examiner rejects claims 15, 24-25, 46 and 54-55 under 35 U.S.C. § 103(a) as being unpatentable over Kajander in view of United States patent application publication No. 2004/0266304 to Jaffee ("Jaffee"). For the reasons provided below, this rejection is traversed.

Notwithstanding the fact that page 4, col. 1, paragraph [0032] of Jaffee does not disclose the use of a binder of glass or mineral fibers as the Examiner contends, the disclosure of Jaffee does not cure the deficiency of Kajander discussed above in reference to the § 102 rejection. The Jaffee does not teach or suggest the weight % range of the binder material claimed in the amended claims 1 and 32. Therefore Kajander and Jaffee whether taken singly or in combination do not teach or suggest the invention claimed in claims 15, 24-25, 46 and 54-55.

Accordingly, withdrawal of the rejection of claims 15, 24-25, 46 and 54-55 and their allowance are kindly requested.

Examiner rejects claims 9-11, 17-18, 40-42 and 48-49 under 35 U.S.C. § 103(a) as being unpatentable over Kajander in view of United States patent application publication No. 2004/0038017 to Tutin *et al.* ("Tutin"). For the reasons provided below, this rejection is traversed.

In particular, Examiner combines the teachings of Kajander and Tutin to contend that the combination discloses the claimed binder concentration in weight percent. Examiner points out that Tutin states in paragraph [0045] that the formaldehyde-free insulation binder of Tutin can be present in an amount of 5-20 weight percent of the insulation product. Examiner then simply states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the insulation of Kajander *et al.* so that it comprised the binder weight percent and the density taught by Tutin *et al.*" This simply is in error.

As discussed above in reference to the §102 rejection, the disclosure of Kajander clearly and explicitly teaches that the binder content of the nonwoven mat of Kajander has to be much lower

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than the weight percent level claimed in claims 9 and 40 as originally filed and now incorporated into amended claims 1 and 32. Kajander states that the binder content is preferably less than 3 weight percent and most preferably between 2-3 weight percent. (See Kajander at paragraph [0018]). This is because the nonwoven mat of Kajander is intended to be laminated between layers of wood in wood composite structures where the bonding strength of the nonwoven mat to the wooden layers is very important. To achieve the required bond strength to the wooden layers, Kajander explains that the invention disclosed therein "is based in part on the discovery that limiting the binder content in the finished mat to a low level greatly improves the bond strength between the mat and wood, or a wood product" (emphasis added) (Kajander at paragraph [0011]). Thus, the disclosure of Kajander teaches away from the binder content claimed in originally-filed claims 9 and 40 which is now incorporated into amended claims 1 and 32 and Kajander cannot properly be combined with Tutin. There is no motivation to combine the two disclosures.

Accordingly, Kajander and Tutin do not teach or suggest the invention recited in originally-filed claims 9 and 40 which is now incorporated into amended claims 1 and 32. Amended claims 1 and 32 are allowable over the references Kajander and Tutin. Their allowance is kindly requested.

The remaining pending claims 2-8 and 10-31 depend from amended claim 1 which is allowable over the cited references. The remaining pending claims 33-39 and 41-61 depend from amended claim 32 which is also allowable over the cited references. Because dependent claims incorporate all limitations of their parent claims, the dependent claims are also allowable over the cited references. Allowance of the dependent claims 2-8, 10-31, 33-39 and 41-61 is kindly requested.

CONCLUSION

Applicant believes that the pending claims as amended are in condition for allowance. Reconsideration of the present application, withdrawal of the rejections and allowance of the pending claims are kindly requested. Should Examiner not agree with Applicants' position, then a telephone interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application.

As shown in the attached Patent Application Fee Determination Record sheet, no additional

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claim fee is believed due for the filing of this amendment and response.

Respectfully submitted,

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